

Amendment B  
S.N. 09/488,614  
Page 4

R E M A R K S

Applicants have made a diligent effort to put the pending claims in condition for allowance. Claims 1-18 were previously canceled without prejudice or disclaimer. Fourteen claims remain pending in the application: Claims 19-32. Reconsideration of the pending claims is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 19-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,808,662 (Kinney et al.) in view of U.S. Patent No. 6,636,888 (Bookspan et al.).

Applicants traverse this rejection and submit a declaration under 37 C.F.R. §1.131 demonstrating that Applicants conceived and reduced to practice the invention as claimed prior to the effective date of the Bookspan et al. patent.

Applicants note that Bookspan et al. was not published more than one year before the filing date of the present application, thus, the Bookspan et al. patent can not be used as a proper reference under 35 U.S.C. 102(b)/103(a).

In order to remove the Bookspan et al. patent cited for the rejection of claims 19-32 under 35 U.S.C. 103(a) Applicants submit evidence establishing a reduction to practice of the claimed invention prior to the filing date of the Bookspan et al. patent, i.e., prior to June 15, 1999; thus, overcoming a rejection under 35 U.S.C. 103(a) by establishing the invention of Applicants' claimed invention prior to the filing date of the Bookspan et al. patent. This evidence is submitted in the form of the following

Amendment B  
S.N. 09/488,614  
Page 5

declaration under 37 C.F.R. 1.131: (a) the Declaration of Evgeniy M. Getsin and Todd R. Collart (hereinafter referred to as "the 131 declaration"). Per MPEP 715.07, the dates have been blocked out of the exhibits attached to the 131 declaration; however, all dates are prior to June 15, 1999.<sup>1</sup>

When any claim of an application is rejected, the inventor of the subject matter of the rejected claim may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the filing date of the reference on which the rejection is based.<sup>2</sup>

A declaration submitted under 37 C.F.R. §1.131 is a proper response to a 35 U.S.C. 103(a). MPEP 715.03 specifically stated, "Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references." Therefore, Applicants submit that the attached 131 declaration is proper in overcoming a 103(a) rejection.

Applicants submit herewith the 131 declaration for execution by Evgeniy M. Getsin and Todd R. Collart demonstrating that Applicants conceived and reduced to practice the invention as claimed prior to the effective date of the Bookspan et al. patent. A fully executed declaration will be submitted in due course, and probably received by the Examiner prior to reviewing this response. Per M.P.E.P. 715.04(B), the declaration is signed by less than all of the named inventors because the subject matter of independent claim 19 was invented only by Evgeniy M. Getsin and Todd R. Collart.

---

<sup>1</sup> The 131 Declaration, paragraph 4  
<sup>2</sup> 37 CFR § 1.131(a) and MPEP 715

Amendment B  
S.N. 09/488,614  
Page 6

The 131 declaration under 37 C.F.R. 1.131 must establish possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it.<sup>3</sup> Proof of a reduction to practice of the invention prior to the filing date of the reference is sufficient to overcome a rejection based upon the reference.<sup>4</sup> Generally, proof of an actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.<sup>5</sup>

As established in the 131 declaration, an online synchronization system utilizing the claimed invention was used prior to June 15, 1999. Thus, the online event described in Exhibits A and the source code for implementing the claimed invention shown in Exhibit B described a system for implementing a method falling within the scope of claim 19, i.e., claim 19 reads upon such described system.

Therefore, given the 131 declaration and Exhibits A and B, it is respectfully submitted that a method covered under claim 19 existed prior to June 15, 1999 and that it would work for its intended purpose.<sup>6</sup>

Thus, as required under MPEP 715.07, it is submitted that a method that includes all of the limitations specified in claim 19 existed prior to June 15, 1999 and that the inventor recognized that the method worked for its intended purpose prior to June 15, 1999.

Thus, Applicants respectfully submit that a rejection of claims 19-32 under 35 U.S.C. § 103(a) is overcome and are in condition for allowance.

---

<sup>3</sup> *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) and MPEP 715.02

<sup>4</sup> 37 CFR 1.131(b) and MPEP 715.07

<sup>5</sup> MPEP 715.07

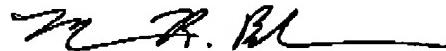
<sup>6</sup> The 131 Declaration Paragraph 9

Amendment B  
S.N. 09/488,614  
Page 7

C O N C L U S I O N

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Thomas F. Lebans at (805) 781-2865 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,



Martin R. Bader  
Reg. No. 54,736

Dated: April 12, 2005

Address all correspondence to:  
FITCH, EVEN, TABIN & FLANNERY  
Thomas F. Lebans  
120 So. LaSalle Street, Ste. 1600  
Chicago, IL 60603  
(805) 781-2865